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10/087,777

03/05/2002

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09/04/2007

EXAMINER

PHAN, MAN U

ART UNIT

PAPER NUMBER

2616

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/087,777

Applicant(s)

GOO ET AL.

Examiner

Man Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 5-6, 9-10, 13, 15 is/are rejected.
- 7) ☒ Claim(s) 3,4,7,8,11 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment and Argument

1. This communication is in response to applicant's 06/18/2007 Amendment in the application of Goo et al. for the "Method for transmitting short message using Internet phones and system therefor" filed 03/05/2002. This application is a Request for Continued Examination (RCE) under 37 C.F.R. 1.114 filed on November 02, 2006. This application claims Foreign Priority based on the application 2001-54383 filed September 05, 2001 in Republic of Korea. The amendment and response has been entered and made of record. Claims 1-13, 15 are pending in the application.
2. Applicant's remarks and argument to the rejected claims are insufficient to distinguish the claimed invention from the cited prior arts or overcome the rejection of said claims under 35 U.S.C. 103 as discussed below. Applicant's argument with respect to the pending claims have been fully considered, but they are not persuasive for at least the following reasons.
3. In response to Applicant's argument that the reference does not teach or reasonably suggest the functionality upon which the Examiner relies for the rejection. The Examiner first emphasizes for the record that the claims employ a broader in scope than the Applicant's disclosure in all aspects. In addition, the Applicant has not argued any narrower interpretation of the claim limitations, nor amended the claims significantly enough to construe a narrower meaning to the limitations. Since the claims breadth allows multiple interpretations and meanings, which are broader than Applicant's disclosure, the Examiner is required to interpret

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the claim limitations in terms of their broadest reasonable interpretations while determining patentability of the disclosed invention. See MPEP 2111. In other words, the claims must be given their broadest reasonable interpretation consistent with the specification and the interpretation that those skilled in the art would reach. See *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000), *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999), and *In re American Academy of Science Tech Center*, 2004 WL 1067528 (Fed. Cir. May 13, 2004). Any term that is not clearly defined in the specification must be given its plain meaning as understood by one of ordinary skill in the art. See MPEP 2111.01. See also *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003), *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003). The interpretation of the claims by their broadest reasonable interpretation reduces the possibility that, once the claims are issued, the claims are interpreted more broadly than justified. See *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). Also, limitations appearing in the specification but not recited in the claim are not read into the claim. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the failure to significantly narrow definition or scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims in parallel to the Applicant in the response and reiterates the need for the Applicant to distinctly define the claimed invention.

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4. Applicant's argument with respect to the rejected claims that the cited references fails to disclose or suggest "*the provision of a short message transmission module in an Internet phone*" as claimed. However, the Short Message Service - SMS may be implemented by two ways. The one way is that a sender connects a web site using Internet and transmits a short message to a recipient using mobile communication terminal. The other way is that a sender using mobile communication terminal sends a short message to a recipient using mobile communication terminal. By using the wireless Internet technology, data provided by server may be transmitted to a user terminal via an Interworking Function, IWF, and a base station. A user may confirm the received data by handling a user terminal. Otherwise, data transmitted from the user terminal may be transmitted to the server via the IWF and the base station. The IWF has a modem and PPP server. Accordingly, users may receive or transmit data using only mobile communication terminal (See Back et al. [00045]-[0007]). The Applicant's attention is directed to the Fig. 2 of US#2003/0036396, in which Back et al. discloses an architectural-level block diagram of a user terminal receiving data by using SMS (Short Message Service) and wireless Internet. The user terminal 410 may comprise a receiver/transmitter 420 for transmitting a URL connecting request (*short message transmit/receive module*), a controller 435 for connecting the communication channel based on application protocols comprised in the received short messages, and storing device 480 for storing program which may be used for executing the controller 435 and connecting the communication channel ([0029] plus).

Since no substantial amendments have been made and the Applicant's arguments are not persuasive, the claims are drawn to the same invention and the text of the prior art rejection can be found in the previous Office Action. Therefore, the Examiner maintains that the references

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cited and applied in the last office actions for the rejection of the claims are maintained in this office action.

Claim Rejections - 35 USC ' 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 5, 9, 13, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rueger et al. (US#2003/0018806) in view of Back et al. (US#2003/0036396).

With respect to claims 1, 9 and 13, 15, Rueger et al. (US#2003/0018806) and Back et al. (US#2003/0036396) disclose a novel system and method for transmitting a short message between Internet phones, according to the essential features of the claims. Rueger et al. (US#2003/0018806) discloses in Fig. 2 a block diagram illustrated the inventive telecommunications network capable of conveying messages originating in mobile stations MS1 and MS2 of a first or a second public land mobile network PLMN1, PLMN2 and terminating in the Internet or in an Intranet. As drawn in Fig. 2 the inventive solution is based on the idea of forwarding the messages from the first service centre SC2 accessed by the mobile stations MS1 and MS2 over a message server WAMS to the second service centre SC1 on a path shown with virtual connections vc1 and vc2. Messages sent by the mobile stations MS1 and MS2 to said virtual mobile stations are forwarded to the message server WAMS where corresponding address information of the recipient application and the service centre SC1 connected thereto is retrieved. Said address information preferably comprises the E.164 address of the service centre SC1 and the address and preferably address type of the recipient application or a related service. Based on the retrieved information the message is forwarded from the message server WAMS to the service centre SC1 (See also Fig. 4; [0010] and [0042]-[0065]). Rueger also teaches the Short Message Transfer layer protocols, in which SMS-DELIVER for conveying a short message from the service centre SC to the mobile station MS; SMS-SUBMIT for conveying a short message from the mobile station MS to the service centre SC; SMS-COMMAND for conveying a command from the mobile station MS to the service centre SC and SMS-DELIVER-REPORT, SMS-SUBMIT-REPORT, SMS-STATUS-REPORT (See Fig. 4; [0060]-[0064]). It's noted that Control of intercommunication between such an

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internet phone and a telephone in a conventional switched circuit network is standardized by the gateway function provided for by ITU Recommendation H.323 protocol. An example of IP telephony gateway is the H.323 gateway (implementing the ITU H.323 standard). H.323 gateways allow interoperation of H.323 systems with other audio/video conferencing systems on Integrated Services Digital Networks (ISDN), plain old telephone systems (POTS), Asynchronous Transfer Mode (ATM), and other transports. An IP telephony gateway operates as an endpoint on the IP-telephony network that provides real-time, two-way communication between IP telephony terminals on the IP-based network and other ITU terminals on a switched-circuit network, or to another IP-telephony gateway. Switched Circuit Network connectivity is achieved in the IP telephony context by using gateways for H.320 (ISDN), H.324, H.323, POTS, and other endpoints on other networks.

In the same field of endeavor, Back et al. (US#2003/0036396) discloses a two-way Short Message Service (SMS) communications between the sender (410) and server (110). The SMS facilitates that a sender sends a short message by using mobile communication service to a recipient, then the recipient can receive the short message. The SMS may be implemented by two ways. The one way is that a sender connects a web site using Internet and transmits a short message to a recipient using mobile communication terminal. The other way is that a sender using mobile communication terminal sends a short message to a recipient using mobile communication terminal (See Fig. 1, [0003]-[0005]). It is assumed that the SMS message being processed is an SS7 transaction capabilities application part (TCAP) or mobile application part-based SMS message. However, an SMS control module/server may be used in a non-SS7 environment to process SMS messages that utilize non-SS7 signaling protocols (e.g., SIP,

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SUA/SCTP, H.323, TALI, etc.). It's noted that telecommunication devices (user equipment) typically communicate with a centralized server, such as a web server, instant messaging (IM) server, or SMS (Short Message Service) server, which performs requested services on behalf of the communications device (user equipment). SMS delivery service provides a mechanism for transmitting "short" messages to and from SMS-capable terminals (e.g., wireless handsets, personal computers, etc.) via the signaling component of the wireless communication network. With particular regard to the sending and receiving of SMS messages by a wireless handset, a wireless network provides the transport facilities necessary to communicate short messages between a short message service center (SMSC) and a wireless handset. A short message service center functions as a store and forward platform for short messages. In contrast to earlier text message transmission services, such as alphanumeric paging, SMS technology is designed to provide guaranteed delivery of an SMS message to a destination. That is, if a temporary network failure prohibits the immediate delivery of an SMS message, then the short message is stored in the network (i.e., at an SMSC) until the destination becomes available. Another of the key and distinguishing characteristics of SMS service with respect to previously available message communication services is that an active mobile handset is able to receive or transmit a short message at any time, regardless of whether or not a voice or data call is in progress (two-way SMS).

Regarding claim 5, It's a method claims corresponding to the system claims 1, 9 above. Therefore, claim 5 is analyzed and rejected as previously discussed with respect to claims 1, 9.

One skilled in the art would have recognized the need for communicating short message service between internet phones using H.323 protocol, and would have applied Back's teaching

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of the executing an IP channel connecting program correspondence with the application protocol into Rueger's novel use of the message server and a telecommunications network for conveying short message. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to apply Back's method for receiving data using SMS and wireless internet and system thereof into Rueger's method and message server for conveying messages in a telecommunications network with the motivation being to provide a method and system for transmitting a short message in an internet phones.

8. Claims 2, 6, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rueger et al. (US#2003/0018806) in view of Back et al. (US#2003/0036396) as applied to the claims above, and further in view of Pang et al. (US#2003/0043762).

With respect to claims 2, 10, Rueger et al. (US#2003/0018806) and Back et al. (US#2003/0036396) disclose the claimed limitations discussed in paragraph 4 above. However, these claims differ from the claims above in that the claims require the feature wherein the the short message transmission server transmits an ARQ for RAS, and receives an ACF message. In the same field of endeavor, Pang et al. (US#2003/0043762) discloses in Fig. 6 a general flow diagram illustrated the call-making methods, in which the standard H.225 RAS admission request and Q.931 setup procedures are performed. The end terminal, such as a H.323 terminal, transmits a H.225 RAS admission request signal to a GK of the packet data network, which contains the identity of the wireless communication device, such as the phone number of a mobile phone. The GK is able to find the corresponding IP address according to an IP transformation table and responds to the H.323 terminal with an H.225 RAS admission

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confirmation signal. The H.323 terminal sends, preferably through a GGSN, a Q.931 setup signal to a VMSC in order to establish a voice communication channel. The VMSC in the present invention communicates with the wireless communication device through a circuit-switched network and communicates with the end terminal through a packet-switched network. Upon receiving a setup signal, the GGSN obtains the PDP context of the identified wireless communication device, such as a mobile phone, according to the IP address identified by a packet received from the H.323 terminal. The GGSN then obtains the GPRS Tunnel ID and SGSN address of the mobile phone from the PDP context and sends the packet to the VMSC. Upon receiving the Q.931 signal, the VMSC responds to the H.323 terminal with a Q.931 call proceeding signal. The VMSC and GK exchange RAS ARQ and Admission Confirmation ("ACF") signals with each other. The VMSC then sends a communication request, in a similar way as illustrated for step 2.3 ([0059]).

Regarding claim 6, it is a method claim corresponding to the system claims 2 and 10 above. Therefore, claim 6 is analyzed and rejected as previously discussed with respect to claims 2, 10.

One skilled in the art would have recognized the need for facilitating the exchange of data between processing units utilizing UTOPIA protocol, and would have applied Pang's teaching of the call set up procedure between VMSC and the packet data network, and Back's teaching of the executing an IP channel connecting program correspondence with the application protocol into Rueger's novel use of the message server and a telecommunications network for conveying short message. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to apply Pang's system and method for

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providing voice communications for radio network, and Back's method for receiving data using SMS and wireless internet and system thereof into Rueger's method and message server for conveying messages in a telecommunications network with the motivation being to provide a method and system for transmitting a short message in an internet phones.

Allowable Subject Matter

9. Claims 3-4, 7-8, 11-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is an examiner's statement of reasons for the indication of allowable subject matter: The closest prior art of record fails to disclose or suggest wherein the short message includes a tag portion, the telephone number of the Internet phone of the calling party, the telephone number of the Internet phone of the called party, and information regarding a length of a main sentence of the short message, as specifically recited in claims.

11. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

12. **THIS ACTION THIS ACTION IS MADE FINAL.** See MPEP ' 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Phan whose telephone number is (571) 272-3149. The examiner can normally be reached on Mon - Fri from 6:00 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Patel, can be reached on (571) 27229884. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

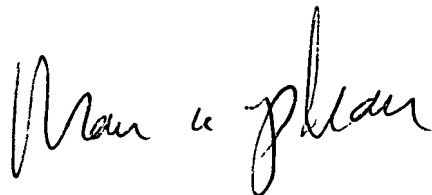
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

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14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at toll free 1-866-217-9197.

Mphan

August 30, 2007

A handwritten signature in cursive script, appearing to read "Mphan", is written in black ink.